

**REMARKS**

Claims 41 and 42 have been added as supported at page 14 last paragraph and page 15, second paragraph.

The claims have been amended as supported by the specification as originally filed, for example at page 4, line 8 and at page 17, lines 11-13 and 17.

No new matter is believed to have been added by entry of this amendment. Entry and favorable reconsideration are respectfully requested.

Upon entry of this amendment Claims 1-27 and 29-42 will now be active in this application.

Applicants respectfully request reconsideration of the application, as amended, in view of the following remarks.

The objection to the claims is obviated by the amendment of the claims and cancellation of Claim 28.

Regarding the provisional double patenting rejection over Serial No. 10/548,878, the MPEP instructs the Examiner to withdraw the provisional rejection if it is the only issue remaining in one case and convert the provisional rejection in the other application to a double patenting rejection. MPEP 822.01. Applicants note that the present case (Serial No. 10/578,568) is the first filed case.

The rejection of Claim 27 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, is obviated by the amendment of the claims. Regarding the lower limit of 20%, the Examiners' attention is drawn to page 17, line 17 which provides support. Thus, the rejection should be withdrawn.

In regard to the Examiner's request to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made, Applicants' Representative is confirming with the Applicants that all claims were and are commonly owned. Applicants' Representative will update the Examiner in the event that the claims are not commonly owned.

The present invention as set forth in **amended Claim 1** relates to a process for producing a moulding from a plastic, comprising:

coating a moulding on one or more sides with a lacquer system,

wherein the lacquer system comprises:

- a) a binder or a binder mixture;
  - b) optionally, a solvent or solvent mixture;
  - c) optionally, a lacquer systems additive; and
  - d) a thickener selected from the group consisting of 0 to 20% by weight of polymeric thickeners and 0 to 40 % by weight of oligomeric thickeners, based on dry film components a), c), d) and e);
  - e) from 5 to 500 parts by weight, based on component a), of an electrically conductive metal oxide in the form of a powder, a dispersion and/or a sol, having a median primary particle size of from 1 to 80 nm and a percentage degree of aggregation of from 0.01 to 99%, wherein said degree of aggregation is based on aggregates which comprise at least two primary particles;
  - f) from 5 to 500 parts by weight, based on component a), of coated inert nanoparticles having a median primary particle size of from 2 to 100 nm; and
- curing said lacquer system.

In contrast, Hino et al fail to disclose or suggest process for producing a moulding, as claimed, in which a lacquer composition is used which comprises e) from 5 to 500 parts by weight, based on a), of an electrically conductive metal oxide powder with a median primary particle size of from 1 to 80 nm and a percentage degree of aggregation of from 0.01 to 99%, **wherein said degree of aggregation is based on aggregates which comprise at least two primary particles** and

f) from 5 to 500 parts by weight, based on component a), of **coated inert nanoparticles having a median primary particle size of from 2 to 100 nm**; and curing said lacquer system.

Hino et al fail to disclose or suggest the subject matter claimed in the dependent claims and in particular in Claims 8-27 and 29-40.

Regarding the median primary particle size (see Advisory Action, page 2), there is nothing in Hino that discloses that this is a result effective variable. A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result- effective variable.).

The same argument applies to the degree of aggregation (see the paragraph bridging ages 2 and 3 of the Advisory Action).

In the present invention, it was surprising to get the same conductivity when using nanoparticles and 33% ITO compared to 50% ITO and no nanoparticles. See page 19, line 35 to page 20, line 9 of the specification. See also page 2, line 22 to page 3, line 12; page 17, line 9 to page 19, line 9.

In addition, the particle size is important, particles up to 3000 nm (Hino et al) are agglomerates and not nano particles. Only the nanoparticles of the invention with 2 to 100 nm lead to the desired technical effects of conductivity and optical properties.

Further, in Example 1, paragraph [0124] of Hino et al. discloses a combination of silica and ATO. However, there is no disclosure or suggestion of an ATO having a percentage degree of aggregation of from 0.01 to 99%, **wherein said degree of aggregation is based on aggregates which comprise at least two primary particles.**

Even if there was any aggregation in Hino et al, a person of ordinary skill in the art would not know what type of particles aggregate based on the disclosure of Hino et al. However, in the present invention it is claimed that the aggregates comprise at least two primary particles.

Yamaya et al, Servaty et al, Hasskerl et al, Liu et al and Anand et al do not cure the defects of Hino et al.

**New Claim 41** relates to a process for producing a moulding from a plastic, comprising:

coating a moulding on one or more sides with a lacquer system,

wherein the lacquer system comprises:

- a) a binder or a binder mixture;
- b) optionally, a solvent or solvent mixture;
- c) optionally, a lacquer systems additive; and
- d) a thickener selected from the group consisting of 0 to 20% by weight of polymeric thickeners, and 0 to 40 % by weight of oligomeric thickeners, based on dry film components a), c), d) and e);
- e) from 5 to 500 parts by weight, based on component a), of an electrically conductive metal oxide in the form of a powder, a dispersion and/or a sol, having a median primary particle size of from 1 to 80 nm and a percentage degree of aggregation of from 0.01 to 99%, wherein said degree of aggregation is based on aggregates which comprise at least two primary particles, **wherein a content of aggregated particles whose particle size is from 50 to 200 nm is 5 to 80% by volume;** and
- f) from 5 to 500 parts by weight, based on component a), of coated inert nanoparticles having a median primary particle size of from 2 to 100 nm; and

curing said lacquer system.

In **new Claim 42**, component e) comprises 25 to 90% of particles agglomerated in a chain-like series.

Hino et al fail to disclose or suggest the subject matter claimed in Claims 41-42.

Yamaya et al, Servaty et al, Hasskerl et al, Liu et al and Anand et al do not cure the defects of Hino et al.

Therefore, the rejections of the claims under 35 U.S.C. § 103(a) over Hino et al, Hino et al in view of Yamaya et al, Hino et al in view of Servaty et al, Hino et al in view of Hasskerl et al, Hino et al in view of Liu et al and Hino et al in view of Anand et al are believed to be unsustainable as the present invention is neither anticipated nor obvious and withdrawal of this rejection is respectfully requested.


This application presents allowable subject matter, and the Examiner is kindly requested to pass it to issue. Should the Examiner have any questions regarding the claims or otherwise wish to discuss this case, he is kindly invited to contact Applicants' below-signed representative, who would be happy to provide any assistance deemed necessary in speeding this application to allowance.

Respectfully submitted,

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